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10/810,689

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Mitsuhiro Naito

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EXAMINER

MANCHO, RONNIE M

ART UNIT

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3663

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,689

Applicant(s)

NAITO ET AL.

Examiner

Ronnie Mancho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,12,15,18,20,7-10,13,14,16,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10,13,14,16,19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-10, 13, 14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamoto (US 6314295).

Regarding claim 7, Kawamoto (abstract; figs. 1-4, 9, 13-15; col. 6, lines 25-40; col. 12, lines 7-40; cols. 5, 8, 9) disclose a navigation device 81 (col. 6, lines 63 to col. 7, lines 67), for installation in a vehicle (col. 12, lines 4-40), comprising:

a communication portion 98 (fig. 2) that is configured to communicate with a server 86 (figs. 1, 3, 4) that distributes data (*abstract; figs. 1-4, 9; col. 6, lines 63 to col. 7, lines 67; cols. 5, 8, 9*);

a network driver 94 (*figs. 2, 14; col. 5, lines 56-65, col. 6, lines 63 to col. 7, lines 67; col. 12, lines 7-40*) necessary for communication between the communication portion and the server 86;

a data storage portion (RAM, col. 6, lines 30-59) that stores the data that is distributed from the server; and

a controller 91 (fig. 2) that:

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starts up the network driver 94 starts up (col. 6, lines 26-39) when an accessory signal causing the navigation device to be supplied with electric power is received from the vehicle;

causes the communication portion 98 to communicate with the server 81 (figs 2 and 3), prior to initiating start-up of other device drivers (*e.g. RAM 93 is instructed to start up storing map data, ID of a base station, the display driver 95 is instructed to start up displaying the map AFTER distribution data from the server and network have been received; col. 6, lines 25-34; col.8, lines 22-34, col. 5, 8, 9, 12 etc*), to determine if there is any pre-specified distribution data in the sever 86 (*that is data from the CPU 91 is communicated to the network driver 94 and then through the communication portion 98 to the server 86, and from the server back to the CPU 91; col. 6, lines 26-39*);

if there is no pre-specified distribution data in the server, starts up the other device drivers (*col.8, lines 22-34, col. 5- 9, 12 etc*); and

if there is pre-specified distribution data in the server, causes the communication portion to communicate with the server to receive the pre-specified distribution data (*col.8, lines 22-34, col. 5, 8, 9, 12*) and starts up the other device drivers after the pre-specified distribution data is received from the server (*e.g. RAM 93 is instructed to start up storing map data, ID of a base station, the display driver 95 is instructed to start up displaying the map AFTER distribution data from the server and network have been received; col. 6, lines 25-34; col.8, lines 22-34, col. 5, 8, 9, 12 etc*).

Regarding claim 8, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9, 12) disclose the navigation device of claim 7, wherein the controller 91:

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initiates start up of the navigation device 81 (col. 5, lines 61-65, col. 6, lines 3-40);

instructs the network driver 94 to communicate with the server 86 (*that is data from the CPU is communicated to the network driver 94 and then through the communication portion to the server*), prior to the start-up of the other drivers (*e.g. RAM 93, display driver 95, etc; col. 6, lines 26-40; col. 12, lines 7-40; cols. 5, 8, 9*).

Regarding claim 9, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9, 12) disclose the navigation device of claim 7, further comprising: at least one of a display portion and a voice output portion, wherein after start-up of the navigation device is completed, data stored in the data storage portion is at least one of displayed on the display portion and voice output from the voice output portion.

Regarding claim 10, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9, 12) disclose the navigation device of claim 7, wherein when an operating system starts up following initiation of a start-up of the navigation device:

the network driver starts up and the pre-specified distributed data is downloaded, and after the pre-specified distributed data is downloaded, start-up of the other device drivers and an application program is executed (*that is data from the CPU is communicated to the network driver 94 and then through the communication portion to the server*), prior to the start-up of the other drivers (*e.g. RAM 93, display driver 95, etc; col. 6, lines 26-40; col. 12, lines 7-40; cols. 5, 8, 9*).

Regarding claim 13, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion is a removable cellular terminal.

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Regarding claim 14, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion communicates directly with the server.

Regarding claim 21, Kawamoto (abstract; figs. 1-4, 9, 13-15; col. 6, lines 25-40; col. 12, lines 7-40; cols. 5, 8, 9) disclose a navigation device, for installation in a vehicle (col. 12, lines 7-40), comprising:

- a communication portion 98 that is configured to communicate with a server 86 that distributes data (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9);

- a network driver 94 (figs. 2, 14; col. 5, lines 61-65, col. 6, lines 3-7; col. 12, lines 7-40) necessary for communication between the communication portion and the server 86;

- a data storage portion (RAM, col. 6, lines 30-59) that stores the data that is distributed from the server; and

- a navigation processing portion 91 that:

 - starts up the network driver 94 when an accessory signal causing the navigation device to be supplied with electric power is received from the vehicle (col. 5, lines 57 to col. 6, lines 40);

 - causes the communication portion 98 to communicate with the server 81 (figs 2 and 3), prior to initiating start-up of other device drivers (*e.g. RAM 93 is instructed to start up storing map data, ID of a base station, the display driver 95 is instructed to start up displaying the map AFTER distribution data from the server and network have been received; col. 6, lines 25-34; col. 8, lines 22-34, col. 5, 8, 9, 12 etc*), to determine if there is any pre-specified distribution data in the sever 86 (*that is data from the CPU 91 is communicated to the network driver 94 and then*

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through the communication portion 98 to the server 86, and from the server back to the CPU 91;
col. 6, lines 26-39);

if there is no pre-specified distribution data in the server, starts up the other device drivers (*col.8, lines 22-34, col. 5- 9, 12 etc*); and

3. if there is pre-specified distribution data in the server, causes the communication portion to communicate with the server to receive the pre-specified distribution data (*col.8, lines 22-34, col. 5, 8, 9, 12*) and starts up the other device drivers after the pre-specified distribution data is received from the server (*e.g. RAM 93 is instructed to start up storing map data, ID of a base station, the display driver 95 is instructed to start up displaying the map AFTER distribution data from the server and network have been received; col. 6, lines 25-34; col.8, lines 22-34, col. 5, 8, 9, 12 etc*).

Regarding claim 7, Ito Yasuo (JP 2001-148092) disclose a navigation device 100 (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant) for installation in a vehicle, comprising:

a communication portion 108 (fig. 2) that is configured to communicate with a server 10 that distributes data (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant);

a network driver 102 (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant) necessary for communication between the communication portion and the server 10; and

a data storage portion 102B (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant) that stores the data that is distributed from the server; and

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a controller 101.

Since the prior art anticipates the structure of the invention, the structure of the prior art is capable of performing the following limitations:

a controller 101 that:

causes the communication portion 98 to communicate with the server, prior to initiating start-up of other device drivers, to determine if there is any pre-specified distribution data in the sever;

if there is no pre-specified distribution data in the server, starts up the other device drivers; and

if there is pre-specified distribution data in the server, causes the communication portion to communicate with the server to receive the pre-specified distribution data and starts up the other device drivers after the pre-specified distribution data is received from the server

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Odashima et al (6650970).

Regarding claim 16, Odashima et al (abstract, cols. 3-5; figs. 1, 6-11) disclose a navigation device 40, for installation in a vehicle (col. 3, lines 16-46; col. 4, lines 43 to col. 5, lines 65), comprising:

means for receiving an accessory signal from the vehicle causing the navigation device to be supplied with electric power (fig. 6; col. 4, lines 43 to col. 5, lines 65);

means 400 for starting up, once the navigation device 40 is supplied with power, a network driver 42 of the navigation device (fig. 6; col. 4, lines 43 to col. 5, lines 65);

means 46 for instructing, prior to initiating start-up of other device drivers (43, 44, 45, fig. 6), the network driver 42 (fig. 6; col. 4, lines 43 to col. 5, lines 65) to communicate with a server 2 (fig. 1) to determine if there is any pre-specified distribution data in the server;

means 42 for starting up the other drivers (43, 44, 45, fig. 6) if the pre-specified distribution data is not in the server; and

means 47 for receiving the pre-specified distribution data from the server 2 using the network driver (fig. 6; col. 4, lines 43 to col. 5, lines 65) if there is the pre-specified distribution data in the server, and starting up the other device drivers (43, 44, 45, fig. 6) after the pre-specified distribution data is received from the server 2

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Regarding claim 19, Odashima et al (abstract, cols. 3-5; figs. 1, 6-11) disclose the navigation device of claim 16, wherein the communication is via wireless communication device 47 or a removable wireless communication device.

6. With regard to claims 7-10, 13, 14, 21, the statements of intended use or field of use, “for installation”, “necessary for communication between”, “starts up the---- when”, “causes the-----to communicate with-----prior to initiating start-up of”, “if there is no.....starts up the”, “if there is ----- causes the----- to communicate”, “starts up after”, etc clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

The MPEP 2114 rejection may be overcome by changing for example “controller that” to “--controller configured to--”, etc

Response to Arguments

7. Applicant's arguments filed 4/25/07 have been fully considered but they are not all persuasive.

Applicant argues that in the invention a controller is not essential and then amends the claim to include a controller. The applicant is therefore contradictory which may imply that the prior art is not required to disclose the claimed controller that performs the method steps claimed.

Applicant further argues that the prior art Kawamoto does not disclose the limitations in the claims. The examiner disagrees. The claims have been amended and have been rejected accordingly as pointed out in the sections above. Applicant indicates that the examiner relies on col. 6, lines 26-40, and col. 12, lines 7-40. The argument is traversed since the applicant omits other sections such as col. 5, 7, 8, 9, figs. 1-4, 9, 13-15, etc cited by the examiner. It implies that the applicant did not consider the prior art as a whole.

The applicant argues the 102 (e) rejection is improper because the examiner did not give patentable weight to the intended use limitations in the apparatus claims. The applicant further pointed out that the reliance on MPEP 2114 was improper and as such the 102 rejection is improper.

The applicant further asserts that the portable terminal 81 is started up before any data from the server has been received. And as such the applicant asserts that Kawamoto fails to disclose the portions of the navigation device that are not necessary for communication with the server are not started up until after the data from the server has been received.

The examiner traverses the argument. The claim limitations do not call for the limitation, “portable terminal is started up before any data from the server has been received”. Instead the invention calls for portions of the navigation device to be started up after data has been received from a server. The prior art anticipates the limitation. It is noted that the argued limitation are not in compliance with MPEP 2114. In addition even if an input section is operated to establish communication of the navigation device with the server as argued by the applicant, other portions of the navigation device are not started up except after receiving data from the server. Applicant further argues that it is well known in the art that a display screen must be started up before information is input in it before communication is established. While is true that a display screen must be started before information it put in it before establishing communication, it is noted that a display screen has many device drivers that must be *initialized* before *star-up* of any of the device drivers. That is there is a big difference between *initialization* and *start up* as disclosed in applicant’s specification pages 1, 2, 16, 17, etc. As known in the art, when device drivers of a display are initialized, some of the device drivers are started up e.g. device drivers that drive the input key functions. Other device drivers such as a device driver to operate a draw-function of a route to a destination is only started up after destination data has been received from a server. Another example is a virtual memory driver of a display screen that starts up a function of temporally storing data after the data has been received from a server. In addition, the RAM device driver in the prior art also starts up to store data after the data has been received from a server. Therefore, not all device drivers in the prior art are started up when communication is established with the server. The prior art therefore anticipates the claims. It is noted that the argued limitation are not in compliance with MPEP 2114.

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Applicant further traverses the rejection based on JP A 2001-148092 on the grounds that the prior art does disclose the method steps in the claims. Applicant's arguments are respectfully traversed. It is noted that the applicant is claiming an apparatus that is not yet configured so as to perform the functions as claimed. The prior art anticipate the structure and is capable of performing the method steps claimed. It is further noted that the applicant already pointed out that the claimed controller is not essential to the invention.

Applicant further argues that the prior art Odashima does not anticipate claim 16 and 19. The applicant asserts that Odashima does not disclose when various parts of the terminal 40 start up relative to communication. The examiner disagrees. Odashima fig. 7 shows that a memory starts up recording data only after the data has been communicated from a server through the internet. Applicant's argument drawn to "whether a contract period has expired" has no basis.

Applicant's arguments traversing the cited MPEP section MPEP 2114 is misplaced because applicant admits that MPEP 2114 is valid for cases where the prior art structure anticipates the structure of the invention. As noted in applicant's arguments, the prior art structure anticipates the structure of the invention. Note! Applicant is not claiming a process, the applicant is claiming an apparatus. Therefore, the rejection is proper.

It is believed that the rejections are proper and thus stand.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663

6/8/07


JACK KEITH
SUPERVISORY PATENT EXAMINER